Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 21

## **REMARKS**

The application has been reviewed in light of the final Office Action dated May 3, 2007. Claims 1-77 are pending. By this Amendment, claims 1, 2, 12, 13, 23, 24, 34, 35, 44, 45, 54, 55, 64, 65, 68, 69, 72, 73 and 77 have been amended to clarify the claimed subject matter, without introducing new issues. Accordingly, claims 1-77 are presented for reconsideration, with claims 1, 12, 23, 34, 44, 54, 64, 68 and 72 being in independent form.

Claims 1, 12, 23, 34, 44, 54, 68 and 72 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

By this Amendment, claims 1, 2, 12, 13, 23, 24, 34, 35, 44, 45, 54, 55, 64, 65, 68, 69, 72, 73 and 77 have been amended to clarify the claimed subject matter, without narrowing a scope of the claims.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1, 12, 23, 34, 44 and 54 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over the Discussion of the Background of this application. Claims 1-3, 5-8, 11-14, 16-19, 22-25, 27-30, 33-36, 38-41, 43-46, 48-51, 53-56, 63, 76 and 77 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over U.S. Patent No. 6,684,283 to Harris et al. in view of U.S. Patent No. 6,061,746 to Stanley et al. Claims 4, 15, 26, 37, 47 and 57 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Harris in view of Stanley and further in view of U.S. Patent No. 6,718,274 to Huang et al. and U.S. Patent No. 4,191,942 to Long.

Applicant has carefully considered the Examiner's comments and the cited art, and respectfully submits that independent claims 1, 12, 23, 34, 44 and 54 are patentable over the

Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 22

cited art, for at least the following reasons.

This application relates to controlling connections of PC cards with a host computer. Fig. 1 of the application shows a conventional PC card control apparatus. In a computer system utilizing such a conventional apparatus (Fig. 1 and the corresponding discussion in the Discussion of the Background of this application), the PC card control apparatus is coupled to the host computer through a PCI bus B3. Since the data format for a non-PCMCIA card is not compliant with the format required for the PCI bus, it must be converted from a format for the USB to a format for the PCI bus.

It is contended in the Office Action that USB B2 in Fig. 1 of the present application equates to a bus interface. However, USB B2 is a bus within the PC card control apparatus 11, and is not a bus interface of the host computer 12. Further, USB B2 connects PC card connector 13 to controller 17 of the PC card control apparatus 11, and not to the host computer 12. In addition, MIJX 15 in Fig. 1 contrary to the implication in the Office Action, does not connect the PC card connector to the host computer.

The Discussion of the Background of this application simply does not disclose or suggest (or provide motivation to modify the subject matter thereof to) a PC card control apparatus comprising an interconnection switching circuit configured to switch the connections of the PC card connector to connect the PC card connector to a bus interface of the host computer dedicated to communicate data in the second data format, upon receiving the detection signal from the card detector, wherein the data is communicated between the bus interface of the host computer and the second PC card in the second data format of the different card standard without converting to the first data format of the predetermined card standard, as provided by the

Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 23

subject matter of claim 1 of the present application.

Harris, as understood by Applicant, proposes a method for interfacing a CardBay card to a host system which includes a system bus and a CardBay controller running CardBus and 16-bit CSS (Card and Select Services) software. The CardBay (or CardBus or 16-bit) card is received through a PC card interface of the host system. In place of the CardBay (or CardBus or 16-bit) card, an adapter bearing a media card may be inserted in the PC card slot.

The interface proposed by Harris, like the conventional apparatus of Fig. 1 of this application, can only communicate with the host via a PCI bus. Accordingly, data from the media card must be converted from its native format to a format for the PCI bus.

Stanley, as understood by Applicant, proposes a system for supporting a Device Bay Controller (DBC) which facilitates adding and upgrading peripheral devices to the host computer through device bays 0-2, connected via a USB bus or 1394 bus and then through a PCI bus to the computer. Since the PCI bus is ultimately utilized for communications with the host, data in a format suitable for the USB bus must be converted to another format that is suitable for communication via the PCI bus.

Accordingly, Stanley like Harris does not disclose or suggest a PC card control apparatus comprising an interconnection switching circuit configured to switch the connections of the PC card connector to connect the PC card connector to a bus interface of the host computer dedicated to communicate data in the second data format, upon receiving the detection signal from the card detector, wherein the data is communicated between the bus interface of the host computer and the second PC card in the second data format of the different card standard without

Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 24

converting to the first data format of the predetermined card standard, as provided by the subject matter of claim 1 of the present application.

Huang and Long were cited only against dependent claims of this application.

Huang, as understood by Applicant, proposes a controller for reading a plurality of expansion cards and controlling operation of the expansion cards, in a host system. Huang was cited in the Office Action as purportedly proposing use of a MUX to select between a CardBus or a PCMCIA bus interface. However, Huang, like Harris and Stanley, requires communication with the host via a PCI bus. Accordingly, data to be communicated to the host which is not suitable for the PCI bus must be converted a format for the PCI bus.

Long, as understood by Applicant, proposes a converter circuit which functions as a single slope A/D converter. Long was cited in the Office Action as purportedly proposing that a multiplexer can be replaced by an analog switch.

However, Applicant does not find teaching or suggestion in the cited art of a PC card control apparatus comprising an interconnection switching circuit configured to switch the connections of the PC card connector to connect the PC card connector to a bus interface of the host computer dedicated to communicate data in the second data format, upon receiving the detection signal from the card detector, wherein the data is communicated between the bus interface of the host computer and the second PC card in the second data format of the different card standard without converting to the first data format of the predetermined card standard, as provided by the subject matter of claim 1 of the present application.

Independent claims 12, 23, 34, 44 and 54 are patentably distinct from the cited art for at least similar reasons.

Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 25

Accordingly, for at least the above-stated reasons, Applicant respectfully submits that independent claims 1, 12, 23, 34, 44 and 54, and the claims depending therefrom, are patentable over the cited art.

The Office Action indicates that claims 9, 10, 20, 21, 31, 32, 42, 52 and 62 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, since independent claims 1, 12, 23, 34, 44 and 54 of the present application are submitted to be patentable over the cited art, no changes to the form of claims 9, 10, 20, 21, 31, 32, 42, 52 and 62 are believed to be necessary.

The Office Action indicates that claims 64-75 also would be allowable if claims 64, 68 and 72 are rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.

Since claims 64, 68 and 72 have been amended in the manner suggested by the Examiner, it is submitted that claims 64-75 are now allowable.

Applicant appreciates the Examiner's statement of reasons for allowance in the Office Action and submits that the allowed claims recite subject matter which further supports patentability for reasons in addition to those identified in the Examiner's statement of reasons for allowance in the Office Action.

In view of the remarks hereinabove, Applicant submits that the application is now in condition for allowance, and earnestly solicits the allowance of the application.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Patent Office is hereby authorized to charge any fees that are required in connection with this amendment and to credit any overpayment to our

Hitoshi YAMAMOTO et al., S.N. 10/816,063 Page 26

Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,

Paul Teng, Reg. No. 40,837 Attorney for Applicant

Cooper & Dunham LLP Tel.: (212) 278-0400